

REMARKS

I. Status of Claims

Claims 1, 2, 4-29, and 31 are currently pending. No claims have been amended by this Response.

II. Rejection under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claim 13 under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to point out and distinctly claim that which Applicant regards as the invention. The Examiner argues that within the various options for "at least one powder," as defined in claim 13, "[t]here are double inclusions," for example nylon, which is both a solid polymer and a filler. Office Action at 2. Applicant respectfully traverses this rejection.

More specifically, Applicant takes the position that double inclusions do not in and of themselves render a claim indefinite. "[T]he double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite."

M.P.E.P. § 2173.05(h). While the claim language in claim 13 is not technically a Markush group, the same rationale applies.

The Examiner asks whether the functional and broad terms in claim 13 "would encompass the specific term listed therein." Office Action at 2. Applicant asserts that the broad terms, such as solid polymer and filler, would encompass the narrower terms, such as nylon. Thus, as evidenced by the Examiner's own understanding of the plain meaning of the terms listed, the Examiner has failed to show that the scope of the claim is unclear, or that one of ordinary skill in the art would be unable to understand the

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scope of each group recited. Therefore, Applicant respectfully requests the withdrawal of this ground for rejection.

III. Rejection under 35 U.S.C. § 103(a)

Claims 1-2, 4-29, and 31 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,221,534 (DesLauriers) in view of U.S. Patent Nos. 6,063,313 (Anton); 6,060,072 (Konik); and 4,528,390 (Kimura), and further in view of U.S. Patent No. 5,945,095 (Mougin).

The Examiner argues that "Des[L]auriers teaches a health[] and beauty aid composition[] comprising a gel made from blends of di- and triblock copolymers." Office Action at 3. The Examiner admits, however, that "Des[L]auriers does not teach expressly the employment of dimethicone, particularly[] in the percentage as recited herein, or the particular[] amount of triblock polymer herein, or the other particular cosmetic ingredients recited herein." *Id.* at 4. The Examiner then resorts to Anton for teaching the use of linear and cyclic silicones as a solvent, Konik for teaching the use of film forming agents in transfer-resistant cosmetics, and Kimura for teaching the use of polymethylsilsequioxane as an additive for cosmetics. *Id.* Thus, the Examiner suggests modifying DesLauriers to arrive at the claimed composition comprising at least one block copolymer film former present in an amount ranging from 0.139% to 1.953%.

Applicant respectfully disagrees and submits that the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case, the Examiner must show, among other things, some suggestion or motivation in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the reference or to combine reference teachings, as well as a

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reasonable expectation of success in making the modification or combination. M.P.E.P.

§ 2143. Here, neither of these criteria has been established.

In particular, DesLauriers specifically teaches away from making the proposed modification to arrive at a composition comprising at least one block copolymer film former present in an amount ranging from 0.139% to 1.953%. Where a reference teaches away from the claimed invention, there is no motivation to combine that reference with others to make the claimed invention obvious. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1350 (Fed. Cir. 2000).

Table 11 of DesLauriers describes the compatibility of a gel made from Kraton[®], a mixture of di- and triblock copolymers, with various cosmetic components, including dimethicone. DesLauriers, col. 13, ll. 12-39. According to this Table, the higher the weight percentage of dimethicone (*i.e.*, the lower the percentage of di- and triblock copolymers), the less compatible the gel became with the dimethicone. Specifically, Table 11 teaches that when 2% dimethicone and 98% gel (presumably this includes 5% of 98% being Kraton[®] block copolymers, for a total of 4.9% Kratons[®]) are used, the sample did not separate. However, at 10% dimethicone (90% gel), which, using the same math, would contain 4.5% Kratons[®], undesirable separation of the sample occurred. At 50% dimethicone (50% gel) and 2.5% Kratons[®], undesirable separation also occurred.

As Table 11 clearly shows that block copolymer film formers present in percentages lower than 4.5% give undesirable results with dimethicone, the reference teaches away from the claimed invention, which comprises at least one block copolymer film former present in an amount ranging from 0.139% to 1.953%. In other words, if

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4.5% of di and tri-block copolymers causes separation of the gel/dimethicone sample, as disclosed by DesLauriers, one of ordinary skill in the art would simply have no motivation to try using a percentage even lower than this, such as the 0.139% to 1.953% range recited in the present claims, with a reasonable expectation of success. Applicant therefore respectfully asserts that no *prima facie* case of obviousness has been established, and the present rejection should be withdrawn.

The Examiner additionally notes that “where the claimed ranges overlap...’ a *prima facie* case of obviousness is made.” Office Action at 6. Applicant disagrees with this statement. M.P.E.P. § 2144.05 instructs that, “if the reference’s disclosed range is so broad as to encompass a very large number of possible distinct compositions, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus.” In turn, “[t]he patentability of a claim to a specific compound or subgenus embraced by a prior art genus should be analyzed no differently than any other claim for purposes of 35 U.S.C. 103.” *Id.* at § 2144.07.

Here, DesLauriers discloses triblock copolymers ranging from 5 to 95 wt% of a 1 to 20 wt% composition, *i.e.*, a total of 0.05 to 19 wt% of triblock copolymers.

DesLauriers, col. 6, ll. 16-36. This broad disclosure encompasses a wide spectrum of possible compositions. Thus, it is analogous to a broadly disclosed genus, wherein the specific species claimed by Applicant is not rendered obvious when analyzed under 35 U.S.C. § 103, as discussed above.

In sum, given the specific disclosure of DesLauriers in Table 11, as well as the broad genus-type disclosure of 0.05 to 19 wt% triblock copolymer, one of ordinary skill in the art would have had neither a motivation to combine the reference teachings nor a

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reasonable expectation of success. DesLauriers teaches away from combining "at least one linear dimethicone" with "at least one block copolymer . . . present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition," as claimed in the present claims. Accordingly, the rejection is in error and should be withdrawn

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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